TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re Application of:	**Dr. Thomas J. Stanley (U.S. Citizen)**
Mark:	**THE MILLIONAIRE NEXT DOOR in Int'l Class 9**
	LAW OFFICE 106
Serial No.:	**76/024,804**
Filed:	**April 13, 2000**

REQUEST FOR RECONSIDERATION
AND ARGUMENTS IN SUPPORT THEREOF

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Attention: Linda A. Powell, Esq.
Trademark Attorney
Law Office 106

Honorable Commissioner:

This Request for Reconsideration and Arguments in Support Thereof is submitted in response to Office Action No. 2 dated February 19, 2002 ("Office Action No. 2").

CERTIFICATE OF MAILING
Date of Deposit: August 19, 2002

I hereby certify that this Request for Reconsideration and Arguments in Support Thereof is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

MICHAEL D. HOBBS, JR., ESQ.

Date of Signature: August 19, 2002

I. INTRODUCTION

The United States Patent and Trademark Office (the "PTO") has made final its refusal to register Application No. 76/024,804 for the mark THE MILLIONAIRE NEXT DOOR (the "Applicant's Mark") in International Class 9 based upon the belief that, pursuant to Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127, the proposed mark is the title of a single work.

The Applicant respectfully requests reconsideration of the application for the following reasons: (1) Applicant's Mark is not merely the title of a single work, but is instead used in connection with a series of works, as shown by samples of the work submitted herewith; and (2) even if the Applicant's Mark is merely the title of a single work, it is entitled to registration based upon (a) current federal and state caselaw (which acknowledges trademark rights in and to single work titles that have acquired secondary meaning), (b) weaknesses in the rationales underlying refusal of registration, and (c) the public policy underlying trademark law and registration in general.

II. LEGAL ARGUMENTS

A. The Applicant's Mark is Used in Connection with a Series of Works.

The Applicant's Mark is entitled to registration because it is used as a designation for a series of works. The word "series" is defined as "a succession of volumes or issues published with related subjects or authors, similar format and price, or continuous numbering." *See Exhibit A.* As set forth in the Applicant's prior Response submitted to the PTO on December 12, 2001 (hereinafter, "Response to Office Action No. 1"), the Applicant's Mark is used in connection with the following series of works in International Class 9:

(1) *The Millionaire Next Door The Surprising Secrets of America's Wealthy* (Audio CD) unabridged on seven compact discs;
(2) *The Millionaire Next Door The Surprising Secrets of America's Wealthy* (Audio Cassette) unabridged on six cassettes;
(3) *The Millionaire Next Door The Surprising Secrets of America's Wealthy* (Audio CD) abridged on two compact discs; and
(4) *The Millionaire Next Door The Surprising Secrets of America's Wealthy* (Audio Cassette) abridged on two cassettes.

The above-referenced abridged works are separate works as compared to the unabridged works referenced above. The Applicant respectfully submits that the fact that the unabridged works appear on seven compact discs or six cassettes and the abridged works appear on two compact discs or two cassettes demonstrates that the abridged works cannot be merely "readings of the applicant's book by the same title" and are not "essentially the same work as the unabridged," as the PTO has suggested.

Instead, the abridged and unabridged works identified by the Applicant's mark is the equivalent of a series of works, namely "a succession of [literary works] published with related subjects or authors." *See Exhibit A.* As further evidence that the abridged and unabridged works are different works, Applicant submits herewith copies of the abridged and unabridged works for the PTO's comparison. *See Exhibit B (copy of abridged audio cassettes and copy of unabridged audio cassettes).* Indeed, the Applicant's abridged and unabridged works are the subject of entirely separate copyright registrations. (Copyright Reg. Nos. SR298767 and SR295831).

These facts, along with the arguments submitted in the Applicant's Response to Office Action No. 1, demonstrate that the Applicant's Mark is used in connection with a series of works and is, therefore, entitled to federal trademark registration.

B. Even If The Applicant's Mark Is The Title Of A Single Work, It Is Entitled To Federal Registration.

1. The PTO Should Permit Registration of Titles of Single Works Because Federal and State Courts Routinely Protect Titles of Single Works as Trademarks Upon a Showing of Secondary Meaning.

It is well settled that U.S. courts extend trademark protection to single work titles upon a showing of acquired distinctiveness, or "secondary meaning." *See Simon & Schuster, Inc. v. Dove Audio, Inc.*, 970 F. Supp. 279 (S.D.N.Y. 1997) (concluding that, based upon showing of secondary meaning, the title *The Book of Virtues* used for hardback book and audiobook of the same title was enforceable as trademark in infringement suit against defendant's publishing of audiobook titled *The Children's Audiobook of Virtues*); *Orion Pictures Co. v. Dell Publ'g Co.*, 471 F. Supp. 392 (S.D.N.Y. 1979) (granting injunctive relief to plaintiff, owner of film titled "A Little Romance," against defendant's use of same title for book); *Dawn Associates v. Links*, 203 U.S.P.Q. 831 (N.D. Ill. 1978) (granting temporary restraining order against defendants who used motion picture title "Return of the Living Dead," which violated plaintiffs' rights in "Night of the Living Dead" motion picture title, which court found had secondary meaning sufficient for trademark protection); *Jackson v. Universal Int'l Pictures, Inc.*, 222 P.2d 433, 87 U.S.P.Q. 131 (Cal. 1950) (upon showing of secondary meaning, title of single play enforceable as trademark against use of same title for motion picture); *Hemingway v. Film Alliance of the United States, Inc.*, 21 N.Y.S.2d 827, 46 U.S.P.Q. 568 (N.Y. Sup. Ct. 1940) (granting injunction against use of title "Fifth Column Squad" for motion picture based upon plaintiffs' prior use of "The Fifth Column" for play that had acquired secondary meaning); *Warner Bros. Pictures, Inc. v. Majestic Pictures Corp.*, 70 F.2d 310 (2d Cir. 1934) (enjoining use of motion picture title "Gold Diggers of Paris" based upon plaintiff's prior use of "The Gold Diggers" and "The Gold Diggers of Broadway"). As these cases demonstrate, courts have routinely recognized that single work

titles -- whether books, plays or motion pictures -- can and do function as trademarks and, thus, are entitled to trademark protection.

In the instant case, however, the PTO, having determined that the Applicant's Mark functions as the title of a single work, has concluded that the Applicant's Mark is not entitled to registration. Denial of federal trademark registration for titles of single works results in situations where the owners of those works may enforce their trademark rights in court, but do not receive any of the beneficial legal presumptions available to owners of federal trademark registrations. *See* 15 U.S.C. § 1057(b) (certificate of registration on principal register "shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate . . ."). The Applicant respectfully submits that even if the Applicant's Mark is the title of a single work and not of a series, the PTO should permit federal registration of the Applicant's Mark upon a showing of acquired distinctiveness to resolve this issue. *See discussion below in Part II(B)(3) regarding public policy supporting registration.*

That Applicant's Mark should be granted federal trademark registration upon a showing of secondary meaning is further supported by the underlying rationale in the seminal case on the subject, *In re Cooper*, 254 F.2d 611, 117 U.S.P.Q. 396 (C.C.P.A. 1958). In *Cooper*, the court, in concluding that registration was not available for a title of a single literary work, relied in large part on the rationale that a title is descriptive of a book: "[H]owever arbitrary, novel or nondescriptive of contents the name of a book -- its title -- may be, it nevertheless describes the book." *Id.* at 615.

To the extent that the *Cooper* case is read as concluding that a single work title may not be registered because it is generic, such a conclusion is misplaced. As the Federal Circuit explained in *In re Dial-A-Mattress Operating Corporation*, "The determination of whether a mark is generic is made according to a two-part inquiry: 'First, what is the genus of the goods or services at issue? Second, is the term sought to be registered . . . understood by the relevant public primarily to refer to that genus of goods or services?'" 240 F.3d 1341, 1344 (Fed. Cir. 2001) (reversing the TTAB's refusal to register the mark 1-888-MATRESS as a service mark for "telephone shop-at-home retail services in the field of mattresses" because the mark is not generic). In that case the court concluded that "telephone shop-at-home mattresses" or "mattresses by phone" were "more apt generic descriptions," but that 1-888-MATRESS was not such a generic term, in part because 1-888-MATRESS referred to only the Applicant's services. Similarly, while "financial books" or "self-help books" might identify the genus of goods incorporating the goods identified by the Applicant's Mark, like the mark at issue in *In re Dial-A-Mattress Operating Corporation*, the Applicant's Mark refers only to goods identifying the Applicant as the common source and not to a genus of goods. Thus, the Applicant's Mark is not generic, and at worst is classified as descriptive.

Descriptiveness issues are nothing new for the PTO. The PTO routinely examines issues of secondary meaning with respect to allegedly descriptive marks, and regularly approves applications where applicants provide evidence of sufficient secondary meaning of marks. Such action is in fact mandated by 15 U.S.C. § 1052(f), which states: "Except as expressly excluded in paragraphs (a), (b), (c), (d), and (e)(3) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce." 15 U.S.C. § 1052(f).

In the case of single work titles, a determination of secondary meaning involves an examination of whether, in the minds of a significant number of people, the title in question is associated with a single source of the literary work. In analyzing secondary meaning with respect to titles of single works, courts have considered a number of factors, including: (1) the length of time in which the title has been used; (2) the extent of advertising and promotion, including expenditures; (3) the success of the works identified by the titles; and (4) the closeness of the geographical and product markets of plaintiff and defendant. *Simon & Schuster*, 970 F. Supp. at 295. Applicant respectfully submits that the PTO should use these same factors to determine whether the Applicant's Mark has acquired secondary meaning for the purposes of federal registration.

As set forth in the Applicant's Response to Office Action No. 1, the Applicant's Mark has been the subject of significant publicity and licensing efforts, widespread sales, and monumental success. Additionally, a search of the Lexis-Nexis "News" database for "The Millionaire Next Door" and "Thomas Stanley" reveals that more than 1,700 U.S. news stories have referenced the Applicant's Mark. *See Exhibit C (representative sample of U.S. news stories).* Thus, the Applicant's Mark has acquired secondary meaning under any test. Because courts have repeatedly held, not that titles of single works do not function as trademarks, but rather that such works are descriptive, the Applicant respectfully submits that even if descriptive, the Applicant's Mark has acquired secondary meaning and is entitled to registration on the Principal Register.

2. Additional Bases for Refusal of Registration of Single Work Titles Likewise Merit Reconsideration.

The refusal to register titles of single literary works has been further rationalized under a number of other theories that provide weak bases for the refusal. For example, the *Cooper* court

attempted to justify its decision refusing registration of a title of a single work by referring to the potential conflict between trademark law and copyright law and the limited duration of protection for works under copyright law. *In re Cooper*, 254 F.2d at 616. As aptly stated by one commentator:

> The only policy addressed by the TTAB and its reviewing courts in connection with Single Work Titles and Names has been the concern for the conflict between the limited duration of copyright protection for literary or musical works, on the one hand, and the potentially unlimited duration of trademark protection, on the other.

James L. Vana, "Single Work Titles and Group, Artist or Author Names -- Registrability Revisited," 88 TRADEMARK REP. 250, 264 (May-June 1998). However, as that author points out, other works, including series of books, public performances by groups or artists, and games, are likewise subject to copyright protection that is limited in duration, yet the PTO permits federal trademark registration of the title of a series of books, a group or artist name for live musical performances and game titles. *See id* at 266. *See also* TMEP § 1202.

Single work titles have also been refused registration pursuant to Sections 1, 2 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052 and 1127, based on the argument that they do not function as a trademark because they do not indicate source. *See Office Action No. 2.* However, the PTO permits federal trademark registration for trade names and model numbers that function as trademarks, despite the fact those marks also serve a non-source indicating function. *See* Vana *supra*, at 260. In examining registerability of single work titles, the PTO should employ the same fact-based approach as it does with trade names and model numbers to determine if a title functions as a source indicator. *Id.* at 263. Under such an analysis, the Applicant's submits that the evidence of secondary meaning contained herein and in Response to Office Action No. 1

should lead the PTO to conclude that the Applicant's Mark does indeed function as a source identifier and, therefore, should be entitled to registration.

3. Public Policy Favors Federal Trademark Registration for Titles of Single Works.

Public policies underlying federal trademark registration provide additional support for registration of single work titles. As the Trademark Trial and Appeal Board itself has so aptly recognized:

> [W]hile not every sign used on a product, or on its label, package, etc., functions as an indication of source of the product on which it is used . . . the broad and liberal interpretation of our law is that, where such a sign also serves a source indicating function, it should be regarded as acceptable subject matter for registration.
>
> . . .
>
> [W]e agree with applicant . . . that it is desirable, absent any overriding public policy considerations . . . to interpret the Trademark Act so that subject matter which is accorded protection in the courts as technical trademarks will be entitled to registration as such.

In re Paramount Pictures Corp., 213 U.S.P.Q. 1111 (T.T.A.B. 1982).

Further, courts have stated that "one of the policies sought to be implemented by the [Lanham] Act was to encourage the presence on the register of trademarks of as many as possible of the marks in actual use so that they are available for search purposes," thus giving a comprehensive notice to those engaged in commerce. *Bongrain Int'l (American) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1485, 1 U.S.P.Q.2d 1775 (Fed. Cir. 1987); *See also In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1220 n.3 (T.T.A.B. 1993). Taking these policies into consideration, along with the evidence of secondary meaning of the Applicant's Mark, there seems to be no reason to deny registration to titles of single works that have become distinctive, including the Applicant's Mark.

III. CONCLUSION

For the foregoing reasons, the Applicant respectfully requests reconsideration of its application and early passage to publication and registration on the Principal Register of the United States Patent and Trademark Office.

Should the PTO have any questions, please do not hesitate to contact the undersigned at (404) 885-3330.

Respectfully submitted,
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August 19, 2002

Via U.S. Mail

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2002 SEP -5 A 8:36
U.S. PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
2900 Crystal Drive
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Attention: Linda A. Powell, Esq.
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Law Office 106

Re: App. Serial No. 76/024804 for THE MILLIONAIRE NEXT DOOR in Int'l Cl. 9
Applicant: Thomas J. Stanley
Our Ref.: 8564.100275

Honorable Commissioner:

Enclosed please find the following documents for filing:

1. Request for Reconsideration and Arguments in Support Thereof, with Exhibits A-C;
2. **For Informational Purposes Only:** Copy of Notice of Appeal and copy of Check No. 296620 in the amount of $100.00 for the Notice of Appeal; and
3. Return postcard.

If any additional or deficient fees are deemed to be payable, please charge our Deposit Account No. 20-1507.

Respectfully submitted,

TROUTMAN SANDERS, LLP

By: _____
Michael D. Hobbs, Jr.

Enclosures

CERTIFICATE OF MAILING
Date of Deposit: August 19, 2002

I hereby certify that this Request for Reconsideration and Arguments in Support Thereof is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

MICHAEL D. HOBBS, JR., ESQ.

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